

REMARKS

Applicant hereby traverses the current rejections, and requests reconsideration and withdrawal in light of the remarks contained herein. Claims 1-2, 4-11, 14-34, and 36-39 are pending in this application.

Amendments to the Specification and Claims

The Specification, including the Title and the Abstract, and the claims have been amended to change “stamp” to “indicium” and change “stamps” to “indicia”. These amendments have been for the purpose of consistency in referring to indicia. No new matter has been entered as basis exists in the specification as filed, for example paragraphs [0005], [0006], and [0032]. Note that the amendments to the claims have been only made for this purpose, and not for the purpose of narrowing their scope in the face of prior art.

Rejection Under 35 U.S.C. § 102

Claims 1-2, 4, 6-12, 15, 18-25, 27-30, 33-34, and 36-39 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ogg.

To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim, *Verdegaal Bros. v. Union Oil Co. of Cal.*, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). The 35 U.S.C. § 102 rejection of record fails to establish a 35 U.S.C. § 102 rejection in accordance with the foregoing requirements.

Applicant respectfully asserts that this rejection is now moot. Applicant has amended claims 1, 9, and 24 to include the subject matter of claims 3, 13, and 35, respectively. As claims 3, 13, and 35 are not subject to this rejection of record, Applicant believes that this rejection has been overcome.

Rejection Under 35 U.S.C. § 103

Claims 3, 26, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ogg.

To show obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. *See In re Vaeck* 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck and Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Finally, the applied reference must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Without conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy the third criteria, as discussed further below.

Independent Claim 1 and Dependent Claims 2, 4, 6-8

Claim 1, as now amended, includes the limitations of now-canceled claim 3.

Claim 1 defines a system for applying postage indicia to mail pieces that includes a controller for monitoring the mail pieces as they are processed by the system. Modified Ogg does not teach at least this limitation. The Examiner asserts that Ogg teaches a computer based postage system, which the Examiner equates with the claimed controller. However, Applicant notes that the computer of Ogg, teaches that associated information regarding a mail piece is entered into the computers, which then determines the proper postage value, see paragraphs [0031] to [0033]. Applicant respectfully asserts that this disclosure is irrelevant to the defined claim limitation. The Examiner has failed to establish that Ogg teaches a controller for monitoring the mail pieces as they are processed. Therefore, Applicant respectfully asserts that the 35 U.S.C. § 103 rejection of record is improper.

Claim 1 also defines that the system includes an applicator for applying the labels to mail pieces. Modified Ogg does not teach at least this limitation. The Examiner relies upon paragraph [0026] of Ogg, which states that once the postage information is printed on a label it may be placed on a mail piece with a recipient of the user's choosing. Applicant notes that nothing in this section teaches an applicator as claimed. Moreover, if the Examiner is relying on inherency as teaching the claimed limitation, then the Examiner has not properly done so. Applicant believes that this portion of Ogg is suggesting that the user places the label onto the mail piece, and the Examiner has acknowledged this assertion, see page 4 of the Final Office Action, line 9. If the Examiner proceeds with equating the user with the claimed applicator, then Applicant notes that the computer of Ogg does not monitor the user processing the mail pieces. Claim 1, defines a controller for monitoring the mail pieces as they are processed by the system, which comprises the applicator. Nothing in Ogg teaches or suggests that the computer monitors the user. Therefore, Applicant respectfully asserts that the 35 U.S.C. § 103 rejection of record is improper.

Claim 1 also defines that the postage evidencing system prints two or more labels for a particular mail piece, the combined postage value of the two or more labels equaling at least the required postage for the mail piece. Modified Ogg does not teach at least this limitation. The Examiner states that Ogg does not disclose printing two or more labels for a particular mail piece, but asserts that it is well known in the art that a sender can use multiple indicia on a mail piece as long as the value of the multiple indicia add up to be at least the required postage, see the Final Office Action at page 13. However, in order to establish prima facie obviousness under 35 U.S.C. § 103, the Examiner must provide analysis supporting any rationale why a person skilled in the art would combine the prior art to arrive at the claimed invention, and "[such] analysis should be made explicit," *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007). Even if it is well known that multiple indicia may be used on a mail piece, there is nothing to support an assertion that one of ordinary skill in the art would have modified Ogg, which teaches the calculation and printing of postage indicia, to print postage indicia of incorrect amounts to therefore print two or more labels for any particular mail piece, nor has the Examiner shown

otherwise. Therefore, Applicant respectfully asserts that the 35 U.S.C. § 103 rejection of record is improper.

Thus, Applicant respectfully asserts that for the above reasons claim 1 is patentable over the 35 U.S.C. § 103 rejection of record, and Applicant respectfully requests that the rejection of record be reversed.

Claims 2, 4, and 6-8 depend from base claim 1, and thus inherit all limitations of claim 1. Each of claims 2, 4, 6-8 sets forth features and limitations not recited by the modification of Ogg. Thus, Applicant respectfully asserts that for the above reasons claims 2, 4, and 6-8 are patentable over the 35 U.S.C. § 103 rejection of record, and Applicant respectfully requests that the rejection of record be reversed.

Independent Claim 24 and Dependent Claims 25-30, 33-34, and 36-39

Claim 24, as now amended, includes the limitations of now-canceled claim 35.

Claim 24 defines a method for creating postage indicia for use on mail pieces that includes monitoring the progress of mail pieces in a high-speed letter processing system. Modified Ogg does not teach at least this limitation. The Examiner asserts that Ogg teaches monitoring the progress of mail pieces in a letter processing system and paragraph [0031], final Office Action at page 14. However, Applicant notes that at paragraph [0031], Ogg merely discusses having a user interface into which a user enters postage information. There is nothing to teach monitoring the progress of mail pieces in a letter processing system, whether high-speed or otherwise. Therefore, Applicant respectfully asserts that the 35 U.S.C. § 103 rejection of record is improper.

Claim 24 also defines that the method is operative for a high-speed letter processing system. Modified Ogg does not teach at least this limitation. The Examiner states that Ogg does not teach a high-speed letter processing system, but asserts that high-speed processing systems are well known in the art as evidenced by Katikaneni et al. (US Pub. 2002/0073052). The

Examiner then states that it is obvious for Ogg's system to be a high-speed processing system. Applicant respectfully disagrees. Applicant notes that the Examiner must provide analysis supporting any rationale why a person skilled in the art would combine the prior art to arrive at the claimed invention, and "[such] analysis should be made explicit," *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007). Merely opining that high-speed processing systems are well known in the art is insufficient to establish obviousness under 35 U.S.C. § 103. Therefore, Applicant respectfully asserts that the 35 U.S.C. § 103 rejection of record is improper.

Claim 24 also defines that the method comprises coordinating the operation of the postage indicium applicator and a postage evidencing system that creates the indicia to ensure that the correct postage indicia are applied to each envelope. Modified Ogg does not teach at least this limitation. The Examiner asserts that Ogg teaches the coordinating in the discussion at paragraph [0034], see the Final Office Action at page 14. However, Applicant notes that this paragraph merely discusses the operation with respect to whether a print wizard was used to generate the request to print computer-based postage indicia. There is nothing to teach coordinating the operation of a postage indicium applicator and a postage evidencing system that creates the indicia to ensure that the correct postage indicia are applied to each envelope. Therefore, Applicant respectfully asserts that the 35 U.S.C. § 103 rejection of record is improper.

Thus, Applicant respectfully asserts that for the above reasons claim 24 is patentable over the 35 U.S.C. § 103 rejection of record, and Applicant respectfully requests that the rejection of record be reversed.

Claims 25-30, 33-34, and 36-39 depend from base claim 24, and thus inherits all limitations of claim 24. Each of claims 25-30, 33-34, and 36-39 sets forth features and limitations not recited by the modification of Ogg. Thus, Applicant respectfully asserts that for the above reasons claims 25-30, 33-34, and 36-39 are patentable over the 35 U.S.C. § 103 rejection of record, and Applicant respectfully requests that the rejection of record be reversed.

Dependent Claim 26

Claim 26 depends from base claim 24, and thus inherits all limitations of claim 24. Claim 26 sets forth features and limitations not recited by the modification of Ogg. Thus, Applicant respectfully asserts that for the above reasons claim 26 is patentable over the 35 U.S.C. § 103 rejection of record, and Applicant respectfully requests that the rejection of record be reversed.

Rejection Under 35 U.S.C. § 103

Claims 5, 13-14, 16-17, and 31-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ogg in view of Patton.

To show obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. *See In re Vaeck* 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck and Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Finally, the applied reference must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Without conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy the third criteria, as discussed further below.

Dependent Claim 5

Claim 5 depends from base claim 1, and thus inherits all limitations of claim 1. Claim 5 sets forth features and limitations not recited by the combination of Ogg and Patton. Thus, Applicant respectfully asserts that for the above reasons claim 5 is patentable over the 35 U.S.C. § 103 rejection of record, and Applicant respectfully requests that the rejection of record be reversed.

Independent Claim 9 and Dependent Claims 10-11 and 14-23

Claim 9, as now amended, includes the limitations of now-canceled claims 12 and 13.

Claim 9 defines a method for printing postage indicia on labels to create postage indicia comprising printing an image on the blank labels in addition to the postage indicia ... wherein the image is selected based upon one or more characteristics of the particular recipient. The combination of Ogg and Patton does not teach at least this limitation. The Examiner admits that Ogg does not disclose that the image is selected based upon a characteristic of the recipient, and relies upon Patton as teaching this limitation. The Examiner asserts that Patton teaches a method of generating indicia with user selected images, and then states that the images can be based on a characteristic of the recipient, see the Final Office Action at pages 15 and 16. Applicant notes that the merely asserting that the images of Patton can be based on a characteristic of the recipient is insufficient to teach that images are selected based upon one or more characteristics of the particular recipient as expressly set forth in the claim. Therefore, Applicant respectfully asserts that the 35 U.S.C. § 103 rejection of record is improper.

Moreover, Applicant notes that Patton does not provide any disclosure to teach selection of an image based upon a characteristic of the recipient. Patton merely teaches that “[w]hen the consumer selects ‘From Collection’ button 70 on decision screen 61 (FIG. 8), the process goes to step 74 and the . . . image category screen 75 displays a plurality of thumbnail-size images 76, which represent different categories of images, such as animals, flowers, landscapes, etc.,” paragraph [0038]. “When the consumer selects an image 76 representing a category on the image category screen 75, the consumer goes to step 78, which displays gallery screen 80 (FIG. 3) comprising a plurality of different thumbnail size images 76 [and t]he consumer chooses an image by selecting the thumbnail of the desired image 76 which results in the selected image appearing in the window of the image manipulation screen 74 (FIG. 14),” *id.* There is nothing in Patton that teaches selection of an image based upon one or more characteristics of the particular recipient. Therefore, Applicant respectfully asserts that the 35 U.S.C. § 103 rejection of record is improper.

Thus, Applicant respectfully asserts that for the above reasons claim 9 is patentable over the 35 U.S.C. § 103 rejection of record, and Applicant respectfully requests that the rejection of record be reversed.

Claims 10-11 and 14-23 depend from base claim 9, and thus inherit all limitations of claim 9. Each of claims 10-11 and 14-23 set forth features and limitations not recited by the combination of Ogg and Patton. Thus, Applicant respectfully asserts that for the above reasons claims 10-11 and 14-23 are patentable over the 35 U.S.C. § 103 rejection of record, and Applicant respectfully requests that the rejection of record be reversed.

Dependent Claims 31-32

Claims 31-32 depends from base claim 24, and thus inherits all limitations of claim 24. Claims 31-32 sets forth features and limitations not recited by the combination of Ogg and Patton. Thus, Applicant respectfully asserts that for the above reasons claims 31-32 are patentable over the 35 U.S.C. § 103 rejection of record, and Applicant respectfully requests that the rejection of record be reversed.

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P022US/10303187 from which the undersigned is authorized to draw.

Dated: February 28, 2008

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: February 28, 2008

Signature: 

Jan Cleveland

Respectfully submitted,

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